

25



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/752,487	12/29/2000	Ann C. Guilford	2000-0615	4140
32943	7590	11/09/2004	EXAMINER	
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			WILLETT, STEPHAN F	
			ART UNIT	PAPER NUMBER
			2141	

DATE MAILED: 11/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

CS

Office Action Summary**Application No.**

09/752,487

Applicant(s)

GUILFORD ET AL.

Examiner

Stephan F Willett

Art Unit

2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/25/04.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 9-14, 36-49, 84 and 85 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-14, 36-49, 84-85 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. With regard to communication that was filed on 3/18/02, this was a change of address filing.
2. Examiners do not acknowledge priority based on provisional applications any longer, only foreign priority is acknowledged on the new office action summaries.

Election/Restriction

1. Applicant's election of Group I in paper filed 8/25/04 is acknowledged. The applicant's arguments with regard to the restriction are not persuasive. There is a burden on the examiner when an additional class must be searched for additional matter claimed in a different subclass, thus the restriction is not withdrawn. The applicant's arguments are now moot.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U. S.C. 102(e) that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-7, 9-14, 36-49, 84-85 are rejected under 35 U.S.C. 102(e) as being anticipated by Dunn et al. with Patent Number 6,591,103.
3. Regarding claim(s) 1, 36, 46, 84-85, Dunn teaches determining a requested service

Art Unit: 2141

associated with the wireless device as services with parameters such as “AMP, CDMA and TDMA”, among others, col. 5, lines 17-23 and a “visitor register”, col. 3, line 33. Dunn teaches determining whether one of the wireless networks can provide a requested service, col. 5, lines 61-64. Dunn teaches if a wireless network can provide the requested service choosing said network, col. 5, lines 64-68 and establishing a parallel session as “continue the call”, col. 5, line 65 and “continue to move”, col. 6, line 5 with a second network. Dunn teaches choosing a network based on a table downloaded periodically, col. 8, lines 42-46; col. 10, lines 58-63 as “information” “broadcasted” during “periods”, col. 10, line 40 from a home service area, col. 5, lines 27-30.

4. Regarding claim(s) 2, 37, 40-41, Dunn teaches choosing a network based on quality of service, col. 9, lines 46-48, minimum rate as “message rate”, delay as “traffic congestion”, col. 5, line 63.

5. Regarding claim(s) 3, 38, Dunn teaches choosing a network based on cost of service, col. 8, lines 26-29.

6. Regarding claim(s) 4, 39, Dunn teaches choosing a network based on preferred provider agreements, col. 7, lines 28-30 as predetermined “internal” data that reflects a providers agreed upon services.

7. Regarding claim(s) 5, Dunn teaches choosing a network based on network capacity as “loads”, col. 11, lines 3-4.

8. Regarding claim(s) 6-7, 42-43, Dunn teaches choosing a network based on network load, col. 11, lines 3-4 presently serving the wireless device, col. 5-6, lines 64-6 or of another network, col. 6, lines 23-26, col. 7, lines 15, 17, 54-55.

Art Unit: 2141

9. Regarding claim(s) 9, Dunn teaches choosing a network based on a table downloaded periodically, col. 8, lines 42-46 and downloaded based on a periodic request, col. 7, lines 34-37.
10. Regarding claim(s) 10, Dunn teaches choosing a network based on updated roaming, col. 4, line 54 agreements, col. 7, lines 28-30 as predetermined “internal” data that reflects a providers agreed upon services and is updated as it is broadcast, col. 8, lines 42-46; col. 10, lines 58-63.
11. Regarding claim(s) 11, Dunn teaches table as “information database” downloading as “listens” when the device is initially turned on, col. 6, lines 3-4.
12. Regarding claim(s) 12-13, 44-45, 48-49, Dunn teaches choosing a network when the device is roaming outside, col. 4, line 54; col. 6, lines 20-21, or inside, col. 4, lines 54-55 as “one network coverage pattern” as home service area, col. 5, lines 27-30.
13. Regarding claim(s) 14, Dunn teaches choosing a network based on a table downloaded periodically, col. 8, lines 42-46; col. 10, lines 58-63 as “information” “broadcasted” during “periods”, col. 10, line 40.
14. Regarding claim(s) 47, Dunn teaches choosing a network based on the strongest signal, col. 4, lines 57-58.

Response to Amendment

15. The broad claim language used is interpreted on its face and based on this interpretation the claims have been rejected.
16. The limited structure claimed, without more functional language, reads on the references provided. Thus, Applicant’s arguments can not be held as persuasive regarding patentability.

Art Unit: 2141

17. Applicant suggests “Dunn does not disclose or suggest a table”, Paper filed 8/25/04, Page 21, lines 10-11. However, Dunn teaches choosing a network based on a table downloaded periodically, col. 8, lines 42-46; col. 10, lines 58-63 as “information” “broadcasted” during “periods”, col. 10, line 40. Also, listening means to download desired information that is being sent is taught. Thus, Applicant’s arguments can not be held as persuasive regarding patentability.

18. Applicant suggests “Dunn does not disclose or suggest a home network”, Paper filed 8/25/04, Page 21, lines 24-25. However, Dunn teaches “home location register”, col. 5, line 30. Said register is for a home network. In any event, “home” is a very broad term and its relative designation changes constantly and depending how and where the term is used relative to other networks. Thus, Applicant’s arguments can not be held as persuasive regarding patentability.

Conclusion

19. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

20. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

1. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephan Willett whose telephone number is (571) 3272-3890.

The examiner can normally be reached Monday through Friday from 8:00 AM to 6:00 PM.

2. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia, can be reached on 571-272-4225. The fax phone number for the organization where this application or proceeding is assigned is 571-273-0044.

3. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

sfw

November 2, 2004



LE HIEN LUU
PRIMARY EXAMINER